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Filed : June 14, 2001

## REMARKS

Applicant has the following comments with respect to the Office Action that was mailed on May 4, 2006. By this paper, Applicant added new dependent claims 45-64.

### Discussion of Claim Rejections under 35 U.S.C. § 103(a)

In the Office Action, the Examiner rejected Claims 1-3, 5-20, 22-26, 28-31 and 33-44 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,543,851, to Chang (hereinafter "Chang") in view of U.S. Patent No. 5,809,471, to Brodsky (hereinafter "Brodsky." Applicant respectfully traverses these rejections.

To establish a *prima facie* case of obviousness a three-prong test must be met. First, there must be some suggestion or motivation, either in the references or in the knowledge generally available among those of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success found in the prior art. Third, the prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). Applicant respectfully submits that the cited references fail to teach or suggest in isolation and in combination at least one limitation from each of the above-listed claims. Furthermore, Applicant respectfully submits that there is no teaching or suggestion to combine the references as suggested by the Examiner.

One embodiment described in the application includes an electronic device that is configured to receive closed caption information. Using an input device, such as a remote control, a user can maintain the close caption information on a display associated with the electronic device. Further the user may select one or more words of the maintained text for transmission over a network to a remote shared database system. Turning to the claims it is seen that independent Claim 1, recites "transmitting, *via a network*, the selected symbols to a *shared* database system that is external to the display" (emphasis added). Independent Claims 3, 7, 20, and 31, each recite similar types of limitations.

Applicant respectfully submits that the cited references do not teach in isolation or in combination at least the foregoing limitation. Chang is generally directed to a translation utility that allows a user to display translations of closed caption information. *See, e.g., Chang*, Figure

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7b. Chang does not retrieve information from a remote database system nor does it retrieve information over a network as is claimed. Applicant also respectfully submits that Chang does not teach or suggest using a shared database.

Furthermore, Applicant respectfully submits that at least these limitations are not taught or suggested by Brodsky. Brodsky describes a system that maintains a buffer vocabulary 104 that is updateable in real time from received input stream. *See Brodsky*, col. 4, lines 49-61. Via user interface 110, a user can select one or more of the words in the buffer and retrieve additional information about the selected word from an application database. *See col. 6, lines 12-42.* Applicant respectfully submits that there is no teaching or suggestion in Brodsky that information from the application database is retrieved via a network. The thrust of Brodsky's invention relates to system for allowing user to get access to Compact Disk—Interactive (CDI) information. *See e.g.*, col. 1, lines 23-36. At best, Brodsky states that: "The application may be on a local or remote CD-ROM or database which includes an encyclopedia." Applicant respectfully submits that the types of media described in the context of the Brodsky patent are conventionally accessible either directly by the receiving device or accessible via a cable, such as an IDE or ATA cable. Applicant respectfully submits that there is no teaching or suggestion that Brodsky could retrieve information over a network, such as the Internet or an Intranet. Furthermore, Applicant respectfully submits that there is no teaching or suggestion in Brodsky that this CD-ROM is shared by multiple users. In contrast, in one embodiment of Applicant's invention, information may be retrieved through the use of an Internet search engine, such as Google or Yahoo.

Furthermore, Applicant respectfully submits that there is no teaching or suggestion to modify Chang and Brodsky with the disparate features suggested by the Examiner in order to derive the presently claimed invention. In the Office Action, the Examiner took the position that "it would have been obvious to one of ordinary skill in the art at the time of the invention by applicant to modify Chang's system to include transmitting, via a network, the selected symbols to a database system that is external to the display as taught by Brodsky, for the typical benefit of providing a user with immediate access to additional content related to the current broadcast."

In response, Applicant submits that this finding does not support a *prima facie* rejection. Applicant respectfully submits that the Examiner can satisfy the burden of showing obviousness

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of the combination or modification “only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fritch*, 972 F.2d 1260, 1265 (Fed. Cir. 1992). Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention. *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546 (Fed. Cir. 1998). The fact that references can be modified is not sufficient to establish prima facie obviousness. *Id.* Furthermore, the fact that the claimed invention is within the capability of one of ordinary skill in the art is not sufficient by itself to establish prima facie obviousness. *Id.* In this case, Applicant respectfully submits that the Examiner has merely made conclusory findings regarding the motivation to modify the Chang system.

Chang and Brodsky are each directed to solving different problems, i.e., Chang is generally directed to providing translation information and, in contrast, Brodsky is generally directed to providing supplementary information that may be maintained in a CD or other database. There is no teaching or suggestion in either reference hinting that the functionality described in the one reference could beneficially be included in the other. Applicant respectfully submits that it is improper to use the claims as a blueprint when determining whether there would have been motivation in the prior art to combine references in a selected fashion. Applicant respectfully submits that the Examiner has selectively picked items from the prior art in hindsight using the benefit of Applicant’s claims. Applicant respectfully submits that there are innumerable features of different systems that *could* be incorporated into the Chang system; however, such fact does not support that one of ordinary skill in the art *would* be motivated to include such features. Here, there is no common problem or solution amongst the cited references that would motivate their combination.

In view that the cited references fail to teach or suggest at least one limitation from each of the above-listed claims and that there is insufficient motivation to combine the references as suggested by the Examiner, Applicant respectfully submits that Claims 1-3, 5-20, 22-26, 28-31, and 33-64 are in condition for allowance.

Furthermore, with respect to Claims 5, 8, 22, Applicant respectfully traverses the rejection of the Examiner. In the Office Action, the Examiner states “The examiner takes

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Official Notice that it was notoriously well known in the art at the time of invention by applicant to utilize an Internet search engine to find relevant information, thereby providing access to a global information network allowing connection to computers and information from around the world, for the typical benefits of taking advantage of a well known, and widely utilized, data network for finding relevant information to a user." Applicant respectfully submits that although Internet search engines were in existence at the time of filing of the application, for the reasons discussed above, there was no teaching in the cited art to provide access to an Internet search engine from an electronic device that receives closed caption data using the received closed caption information.

#### CONCLUSION

In light of these remarks, reconsideration and withdrawal of the outstanding rejections is respectfully requested.

Respectfully submitted,

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